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03560.002609 (35.G2609)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: )  
: Examiner: Scott A. Rogers  
HIROSHI MATSUSHIMA )  
: Group Art Unit: 2626  
Appln. No.: 09/604,980 )  
: Confirmation No. 6443  
Filed: June 28, 2000 )  
:   
For: IMAGE-CAPTURING APPARATUS, )  
METHOD OF CONTROLLING THE :  
SAME APPARATUS, AND )  
COMPUTER PROGRAM PRODUCT :  
FOR PROVIDING THE SAME )  
METHOD :  
:   
Patent No.: 6,862,106 B1 :  
:   
Issued: March 1, 2005 : April 29, 2005

**Mail Stop Patent Ext.**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF  
PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

05/02/2005 HVUONG2 00000074 6862106

01 FC:1455 Sir: 200.00 OP

RELIEF REQUESTED

Patentee hereby requests reconsideration and recalculation of the Patent  
Term Adjustment (PTA) for the above-identified patent. Under 37 C.F.R. § 1.705(d). For  
the following reasons, this patent is believed to be entitled to a PTA of 939 days.

## FACTS

1. On September 29, 2004, a Notice of Allowance was mailed in the subject application. The Notice of Allowance correctly indicated a PTA of 939 days, calculated pursuant to 1.703(a)(1) as the number of days in the period beginning on the day after the date that is fourteen months after the date on which the application was filed and 35 U.S.C. 111(a) and ending on the date of mailing of an action under 35 U.S.C. 132.

2. The Issue Fee was paid on November 18, 2004.

3. On or about December 9, 2004, Patentee's representatives were contacted by a Ms. Kay Pinkney of the Publications Branch of the U.S. Patent and Trademark Office (the USPTO), because the USPTO was unable to find a copy of an executed declaration for this case.

4. On December 9, 2004, Patentee's representative forwarded to Ms. Pinkney, via facsimile, Patentee's representatives' file copy of the executed declaration.

5. According to the USPTO's Patent Application Information Retrieval (PAIR) system, the Oath or Declaration scanned into the image file wrapper was filed on December 14, 2004. The USPTO has assigned 78 days of Applicant delay to this paper.

6. On March 1, 2005, the subject patent issued indicating a PTA of 861 days, i.e., 939 days less the 78 days.

7. However, the declaration had previously been timely filed on November 6, 2000, with a Response to Notice to File Missing Parts of Nonprovisional Application. (Copies of the Response and of the stamped post card indicating receipt thereof by the USPTO are attached.)

8. The patent is not subject to any terminal disclaimer.

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 C.F.R. § 1.704.

### ARGUMENT

Patent term adjustment is reduced by the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution. See 35 U.S.C. § 154(b)(2)(C)(i). When papers are filed after the mailing of a Notice of Allowance, such failure is present when the paper causes “substantial interference and delay in the patent issue process”. See O.G. Notice "Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed" dated June 26, 2001 (copy attached). According to the Notice, papers said to cause such interference and delay include (1) a request for a refund, (2) a status letter, (3) amendments under 37 C.F.R. § 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

While “oath or declarations” is indicated as cause of interference and delay, the executed declaration was not “filed” on December 14, 2004, in this case. The declaration was timely filed on November 6, 2000. Patentee’s representatives merely provided the Publications Branch with a courtesy copy of the previously-filed declaration, at the request of the Publications Branch, apparently because the USPTO had misplaced

the originally filed declaration. Thus, Patentee submits that there was no Applicant delay in this case, and therefore respectfully submits that the 78 days charged as Applicant delay should be reconsidered.

#### CONCLUSION

In view of the foregoing, favorable consideration hereof and reconsideration and recalculation of the PTA to be 939 days are earnestly solicited.

#### FORMAL MATTERS

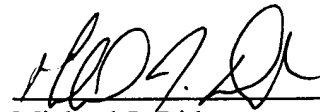
Submitted herewith is a check for \$200.00 for the fee set forth in 37 C.F.R. § 1.18(e). Any deficiency in this fee may be charged or any overpayment credited to Deposit Account No. 06-1205.

#### REQUEST FOR INTERVIEW

If any questions remain, Patentee respectfully requests that the U.S. Patent and Trademark Office contact Patentee's undersigned representative at (202) 530-1010 to schedule an interview.

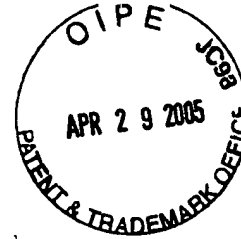
Patentee's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "MJD", is written over a horizontal line.

Michael J. Didas  
Attorney for Patentee  
Registration No. 55,112

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3800  
Facsimile: (212) 218-2200  
MJD:eyw



Clarification of 37 CFR 1.704(c)(10) -  
Reduction of Patent Term Adjustment for  
Certain Types of Papers Filed  
After a Notice of Allowance has been Mailed

Patent term adjustment under 35 U.S.C. 154(b)(1) is reduced by the period of time during which the applicant "failed to engage in reasonable efforts" to conclude prosecution (i.e., processing or examination of an application). See 35 U.S.C. 154(b)(2)(C)(i). Pursuant to 35 U.S.C. 154(b)(2)(C)(iii), the United States Patent and Trademark Office (Office) has prescribed regulations setting forth the circumstances constituting a failure to engage in reasonable efforts to conclude prosecution (i.e., processing or examination of an application). See 37 CFR 1.704. After a "Notice of Allowance" has been mailed, submissions by an applicant that cause a delay in processing or examination of an application will be considered a "failure to engage in reasonable efforts" to conclude prosecution. See 37 CFR 1.704(c)(10) ("failure to engage in reasonable efforts" to conclude prosecution includes submission of an amendment under 37 CFR 1.312 or other paper after a "Notice of Allowance" has been mailed). The reason such a submission is considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application is that delaying the submission of such papers until after an application is allowed causes substantial interference and delay in the patent issue process. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56373 (Sept. 18, 2000); 1239 Off. Gaz. Pat. Office 14, 19-20 (Oct. 3, 2000) (final rule).

It should be noted, however, that only certain papers (not all papers), filed after a "Notice of Allowance" is mailed, cause substantial interference and delay in the patent issue process. Therefore, it is the filing of these papers that will be considered a "failure to engage in reasonable efforts" to conclude processing and examination of an application under 37 CFR 1.704. The Office has reviewed many allowed applications (mostly continued prosecution applications (CPAs)) that were filed on or after May 29, 2000, in which the issue fee was paid. The review consistently showed that only certain papers submitted after a "Notice of Allowance" is mailed, interfered with and delayed the patent issue process to such a degree as to constitute a "failure to engage in reasonable efforts" to conclude processing or examination of an application.

Accordingly, the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in

reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

In contrast, the submission of other papers after a "Notice of Allowance" is mailed that do cause substantial interference and delay in the patent issue process are considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application pursuant to 37 CFR 1.704(c)(10). The following are examples of such papers: (1) a request for a refund, (2) a status letter, (3) amendments under 37 CFR 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

As guidance for minimizing reductions to any patent term adjustment, applicants should adopt practices that do not delay processing of the applications after the "Notice of Allowance" has been mailed. For instance, instead of filing corrected drawings or editorial amendments after the application has been allowed, applicant should submit such corrected drawings or editorial amendments prior to allowance of the application. In addition, instead of filing a status letter, applicant should use the private Patent Application Information Retrieval (PAIR) system to determine the status of the application (<http://pair-direct.uspto.gov>) or call the Office.

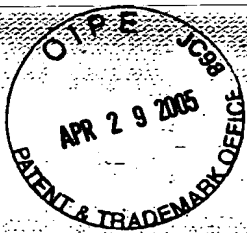
The Patent Application Locating and Monitoring (PALM) system maintains computerized contents records of all patent applications and reexaminations. PAIR is a system that provides public access to PALM for patents and applications that have been published (i.e., information for applications maintained in confidence cannot be obtained), which can be accessed over the Internet at <http://pair.uspto.gov>. The private side of PAIR at <http://pair-direct.uspto.gov> can be used by an applicant to access confidential information about his or her pending application. To access the private side of PAIR, a customer number must be associated with the correspondence address for the application, and the user of the system must have a digital certificate. For further information, contact the Customer Support Center of the Electronic Business Center at (703) 305-3028.

In addition, if PAIR is used to see the PALM records that are relied upon for patent term adjustment purposes, a contents entry with the contents code "DRWS" and the contents description "DRAWING REQUIREMENTS SATISFIED" does not indicate when the drawings were filed and is not a PALM entry that is used in the patent term adjustment calculation.

Any questions or comments about this change should be directed to Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Ms. Tyson can be reached by telephone at (703) 306-3159, or by e-mail at [Karin.Tyson@uspto.gov](mailto:Karin.Tyson@uspto.gov).

May 29, 2001

NICHOLAS P. GODICI  
Acting Under Secretary of  
Commerce for Intellectual Property and  
Acting Director of the United States  
Patent and Trademark Office



Director, the Commissioner for Patents  
Washington, D.C. 20231

Date 11 / 6 / 00  
Mo. Day Yr.  
Atty. Docket 35.62609  
Application No. 09/604,980

Sir:

Kindly acknowledge receipt of the accompanying:

- ☒ Response to ~~Official Action~~ *notice to file missing part, executed declaration, copy of notice*
- ☒ Check for \$ 130.00 (claims fee) *surplus*
- ☐ Petition under 37 CFR 1.136 and Check for \$ \_\_\_\_\_
- ☐ Notice of Appeal and Check for \$ \_\_\_\_\_
- ☐ Information Disclosure Statement, PTO-1449 and \_\_\_\_\_ documents
- ☐ Claim for priority and certified copies of \_\_\_\_\_ priority applications
- ☐ Issue fee transmittal and Check for \$ \_\_\_\_\_
- ☐ Other (specify) \_\_\_\_\_

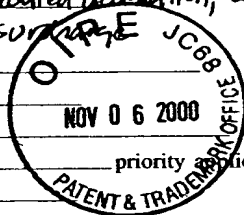
by placing your receiving date stamp hereon and mailing or returning to deliverer.

Atty. SWO/amv

Due Date 11 / 8 / 00  
Mo. Day Yr.

37 CFR 1.8 ☐  
37 CFR 1.10 ☐  
By Hand ☒

FOHS-B-95







35.G2609

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
HIROSHI MATSUSHIMA ) Examiner: Not Assigned  
Application No.: 09/604,980 ) Group Art Unit: 2722  
Filed: June 28, 2000 )  
For: IMAGE-CAPTURING APPARATUS, ) November 6, 2000  
METHOD OF CONTROLLING THE )  
SAME APPARATUS, AND COMPUTER )  
PROGRAM PRODUCT FOR )  
PROVIDING THE SAME METHOD )

Box Missing Parts  
The Commissioner for Patents  
Washington, D.C. 20231

**ATTENTION: APPLICATION PROCESSING DIVISION, SPECIAL PROCESSING AND  
CORRESPONDENCE BRANCH**

RESPONSE TO NOTICE TO FILE MISSING  
PARTS OF NONPROVISIONAL APPLICATION

Sir:

In response to the NOTICE TO FILE MISSING PARTS OF  
NONPROVISIONAL APPLICATION mailed September 8, 2000, enclosed please  
find an executed Declaration/Power of Attorney form, together with the  
surcharge fee of \$130.00. Also enclosed is a copy of the NOTICE TO  
FILE MISSING PARTS OF NONPROVISIONAL APPLICATION.

The Commissioner is authorized to charge any additional  
fees or credit any overpayment to Deposit Account No. 06-1205. A  
duplicate of this paper is attached for that purpose.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

\_\_\_\_\_  
Attorney for Applicant

Registration No. \_\_\_\_\_

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

SWO\cmv